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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,652	03/17/2004	Alan Smithies	15880.10026	2651
27128 7590 08/23/2007 BLACKWELL SANDERS LLP 720 OLIVE STREET SUITE 2400 ST. LOUIS, MO 63101			EXAMINER CAMERON, ERMA C	
			ART UNIT 1762	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,652	<b>Applicant(s)</b> SMITHIES, ALAN	
	<b>Examiner</b> /Erma Cameron/	<b>Art Unit</b> 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,9-11,14-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16,17 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9-11,14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4, 7, 9-11 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 1 and 9: it is not clear if the pleating occurs after treating and curing or after only the treating step.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

Art Unit: 1762

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed does not teach a pleating temperature above 430 degrees C. This is new matter. The applicant is requested to cancel all new matter.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 726348.

'348 teaches applying a stiffening agent such as PAI (3:14-17) to a porous fibrous substrate such as an aramid substrate (see Example 1) to make a filter. The PAI is present at 1-30 wt% solids (3:19), which overlaps with applicant's claimed 5.5 wt%.

The material is then pleated at 200-250 degrees C (328-418 degrees F) (4:39-41). The operating temperature is as low as 200 degrees C (328 F) (2:33-39) or as high as 365 C (625 F).

If the pleating occurred at 250 degrees C (418 F) and the operational T is 240 C (400F), the process of '348 meets both the application (operational) T over 375 F and pleating at a higher T than the operating T.

Art Unit: 1762

The application amount is 2.5 to 23% of the weight of the fabric (see Table 2) which overlaps with applicant's claimed range.

Because '348 uses the same materials and forms the filter by the same processes, the filter formed by '348 must inherently possess the same capabilities as applicant's claimed filter, including the ability to withstand the same number/condition of cleaning pulses.

### ***Response to Arguments***

The applicant has argued that '348 does not teach pleating above 375 F. The examiner disagrees. '348 teaches pleating at 200-250 C (328-418 F). The upper end of this range is >375 F.

The applicant argues that composition I of '348 results in a substrate with less strength that could not withstand the cleaning pulses. However, '348 states that the "tongue tear strength" (4:43) is less for composition I treated fabric and the applicant has not shown how this compares to or effects the ability to withstand cleaning pulses. In addition, the solids content of composition I is 18.7% solids. The range of composition for PAI in '348 is 1-30 % solids (3:19), and the applicant has not shown that lower solids compositions, more in line with that claimed by applicant, would have the same effect.

The applicant also argues that '348 could not stand the cleaning pulses that are claimed. The examiner disagrees. The substrate of '348 and of the claimed invention get essentially the same treatments, and would inherently then have the same properties.

Art Unit: 1762

Regarding claim 7, this was inadvertently omitted from the claims being rejected under '348. The statement at the top of page 3 of the 1/30/2007 office action addresses the limitations of claim 7.

7. Claims 2, 9-11 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 726348 taken in view of Fukata (4454189) or EP 1096057.

'348 is applied here for the reasons given above.

'348 fails to teach the calendaring step.

'057 teaches a calendaring step for fabric that is to be used to make a filter, both to adjust the thickness and to compact the fibers at the surface ([0054]).

'189 teaches calendaring fabric that will be made into a filter to compact it and give it wet strength (4:20-29, 7:11-15).

It would have been obvious to one of ordinary skill in the art to have added the calendaring step of '057 or '189 to the '348 process because of the advantages the calendaring process adds – adjusting thickness, compacting the fabric and giving it wet strength.

### ***Response to Arguments***

The applicant has argued that Wyss, Fukata and Nakahara, alone or in combination, do not suggest claim 1. However, only Wyss alone is being used for claim 1. Wyss in combination with one of the other references is being applied against claims 2, 9-11 and 14-15. Fukata and

Art Unit: 1762

Nakahara are used for the purposes of bringing a calendaring step into the Wyss process, and do not teach cleaning pulses, etc.

*Allowable Subject Matter*

8. Claims 16-17 and 19-21 are allowed.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1762

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Erma Cameron/  
Primary Examiner  
Art Unit 1762

August 17, 2007